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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/757,688	01/14/2004	Lisa S. Purvis	D/A3267 (1508/3940)	4094
13643	7590	11/07/2011		
LeClair Ryan (Xerox ROC) 290 Linden Oaks, Suite 310 Rochester, NY 14625				
EXAMINER				
TSUL, WILSON W				
ART UNIT		PAPER NUMBER		
2178				
MAIL DATE		DELIVERY MODE		
11/07/2011		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Advisory Action  
Before the Filing of an Appeal Brief**

**Application No.**

10/757,688

**Applicant(s)**

PURVIS ET AL.

**Examiner**

WILSON TSUI

**Art Unit**

2178

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 20 October 2011 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.  
NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.

6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 1-29.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.

12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_

13. ☐ Other: \_\_\_\_\_.

/Stephen S. Hong/  
Supervisory Patent Examiner, Art Unit 2178

Continuation of 11. does NOT place the application in condition for allowance because:

With regards to claim 1, the applicant argues that "... however, Fein fails to teach or disclose determining or applying a paragraph style based on the characteristics of the output device on which the original document is going to be displayed.

However, this argument is not persuasive since the Applicant is arguing limitations not present in the claim language. More specifically, the claim language cites "based on the characteristics of the output system"; while the applicant is arguing that that Fein fails to teach "based on the characteristics of the output device". Since the claim language only requires the output system, and the claim language does not expressly indicate that the output "system" has to be the output "device" itself. Thus, since as explained in the previous rejection (Abstract, Fig 2A of Fein et al), one or more mutators/styles are obtained from a repository/list of mutators/styles, that correspond to particular types of paragraph documents, wherein one or more mutators/styles are applied based on one or more characteristics of the designated output system (the output system being defined/characterized by the logic/conditional execution pathways to implement a rendering/application of a style, as illustrated in Fig 2A) and also based on type of paragraph document that matches the portion of the original paragraph document, as explained in the identification of a paragraph in 215 of Fig 2A). Should the applicant desire ... "based on the characteristics of the output device", the examiner recommends the applicant include this in the claim language to expedite the prosecution of the application.

Additionally, the Applicant argues that "Fein teaches if the major formatting properties of the paragraph match those of an existing paragraph style with the same paragraph type of the paragraph ... then the matching existing style is only applied to the paragraph portion of the document".

However, this argument is not persuasive since the Examiner has already explained that the paragraph can be interpreted as a document (collection of data), and therefore Fein is interpreted to similarly teach: if the major formatting properties of the paragraph document (original paragraph/document) match those of an existing document style (type of document). In other words, a style/mutator is selected based upon a type of document that matches the portion of the original document, and therefore, Fein still teaches the required claim language.

To help best expedite the prosecution of the application, the Examiner respectfully notes/recommends that the Applicant clarify in the claim language what particular attributes/characteristics are used to determine a particular "type of document". This clarification will help distinguish the applicant's invention from the prior cited art.

With regards to claims 9 and 18, the applicant argues that they are allowable for reasons similar to the reasons that claim 1 was allowable. However, this argument is not persuasive since claim 1 has been shown/explained to be rejected.

The applicant lastly argues that hindsight was used to combine Zlotnick, Niyogi and Fein. However, In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See In re McLaughlin, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). More specifically, as explained in the response to arguments above, Fein encourages choosing a style/mutator to apply based upon a type of paragraph document that matches the portion of the original paragraph document. Thus, the teachings are from Fein, rather than hindsight reasoning, and as also explained above in the response to arguments, clarification to the claim language to what features/characteristics describe a "type of document" would help distinguish the applicant's invention from the cited prior art.

With regards to claims 2-8 and 27, the applicant argues that they are allowable since they depend directly or indirectly upon claim 1. However, this argument is not persuasive since claim 1 has been shown/explained to be rejected.

With regards to claims 10-17 and 28, the applicant argues that they are allowable since they depend directly or indirectly upon claim 9. However, this argument is not persuasive since claim 1 has been shown/explained to be rejected.

With regards to claims 19-26, and 29, the applicant argues that they are allowable since they depend directly or indirectly upon claim 18. However, this argument is not persuasive since claim 1 has been shown/explained to be rejected.